

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
108910-08056

First named inventor: BRINATI

Application No.: 08/885,770

Filed: June 30, 1997

Title: VDF Polymerization Process



Art Unit: 1713

Examiner: SAROFIM

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1500.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Continued Prosecution Application (identify type of reply):

☒ has been filed previously on June 30, 1997.
☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.


Signature

September 14, 2005

Date

Richard J. Berman

39,107

Typed or printed name

Registration Number, if applicable

Arent Fox PLLC, 1050 Connecticut Avenue, N.W.

202-857-6232

Address

Telephone Number

Washington, DC 20036-5339

Address

Enclosures: ☐ Fee Payment☒ Reply☐ Terminal Disclaimer Form☒ Additional sheets containing statements establishing unintentional delay☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

Date

Signature

Typed or printed name of person signing certificate



DAC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Brinati *et al.*

Group Art Unit: 1713

Application Serial No.: 08/885,770

Examiner: Sarofim, N.

Filed: June 30, 1997

Attorney Docket No.: 108910-08056

For: VDF Polymerization Process

September 14, 2005

* * * * *

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. §1.137(e)

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The applicants respectfully request reconsideration of the Decision on Petition dated August 23, 2005.

The applicants' previous Petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment was dismissed under 37 C.F.R. §1.181(f) because it was not filed within 2 months of the mailing date of the Notice of Abandonment (dated March 29, 1999). In response, the applicants respectfully submit that:

- (1) they were unaware of the relevance of the prior Notice of Abandonment until just before December 2, 2004, at which point they filed the Petition under 37 C.F.R. §1.181(a);
- (2) the applicants clearly filed a Request Form For Continuing Prosecution Application under 37 CFR §1.53(d) along with an Amendment and Petition for Extension of Time for two months on January 13, 1999. Therefore the original Notice of Abandonment was improperly issued by the U.S. Patent and Trademark Office; and

(3) 37 C.F.R. §1.181(f) permits the Director of the U.S. Patent and Trademark Office to grant this petition regardless of the delay ("Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." (emphasis added)).

The applicants respectfully submit that they have made a *bona fide* attempt to respond to the Notice of Abandonment as soon as they became aware of it and respectfully request that the Director reconsider the Decision on the applicants' Petition and grant this Petition.

In the alternative, if the Director rejects the applicants' Request for Reconsideration, the applicants enclose a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 C.F.R. §1.137(b) along with copies of the relevant documents. The Director is authorized to charge the amount of \$1500.00 to cover the petition fee under 37 C.F.R. §1.17(m) to Deposit Account No. 01-2300, referencing Attorney Docket No. 108910-08056, if the Director accepts the applicants' Petition for Revival of an Application for Patent Abandoned Unintentionally.

The applicants believe that no fee is due for this Request for Reconsideration. In the event that a fee is required, it may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. 108910-08056.

Respectfully submitted,

ARENT FOX PLLC

A handwritten signature in black ink, appearing to read "Richard J. Berman", is written over a horizontal line. The signature is stylized and cursive.

Richard J. Berman

Registration No.: 39,107

Customer No.: **004372**

1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5339

Telephone No.: 202-857-6000
Facsimile No.: 202-857-6395

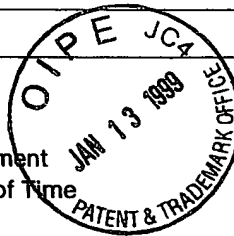
RJB/GP



BEST AVAILABLE COPY

Patent ☒ Trademark ☐ Docket No. P8910-8056
Serial No. 08/885,770 Filed June 30, 1997
Applicant(s) BRINATI et al.
Papers filed herewith on January 13, 1999

<input checked="" type="checkbox"/> Fees \$ <u>1140.00</u>	<input type="checkbox"/> Assignment
<input type="checkbox"/> New Application	<input type="checkbox"/> Declaration
<input type="checkbox"/> Amendment	<input type="checkbox"/> Priority Document
<input type="checkbox"/> Notice of Appeal	<input checked="" type="checkbox"/> Req. for Ext. of Time
<input type="checkbox"/> IDS/PTO-1449	<input type="checkbox"/> Drawings
<input checked="" type="checkbox"/> Other <u>Rule 53d Continued Prosecution Application; Preliminary Amendment</u>	

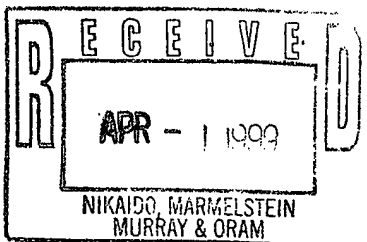


Receipt is hereby acknowledged of the papers filed as indicated in connection with the above-identified case.

Check No. 18459
POU/fcs

COMMISSIONER OF PATENTS

due 1/20/99



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER 08/145,770	FILING DATE 06/30/97	FIRST NAMED APPLICANT NIKAIKO, MARMELESTEIN MURRAY & ORAM	ATTORNEY DOCKET NO. 347-76453
----------------------------------	-------------------------	--	----------------------------------

NIKAIKO, MARMELESTEIN MURRAY & ORAM, LLP
METROPOLITAN SQUARE
655 15TH ST NW
SUITE 3000
WASHINGTON, DC 20005-0501



EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

03/29/98
DATE MAILED:

NOTICE OF ABANDONMENT *Chm*

This application is abandoned in view of:

- ☒ Applicant's failure to timely file a proper response to the Office letter mailed on 8/20/98.
 - ☐ A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of _____ month(s)) which expired on _____.
 - ☒ A proposed response was received on 12/7/98, but it does not constitute a proper response to the final rejection.
- ☐ (A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)
- ☐ No response has been received.
- ☐ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
 - ☐ The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.
 - ☐ The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.
 - ☐ The issue fee has not been received.
- ☐ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
 - ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.
 - ☐ The proposed new formal drawings filed _____ are not acceptable.
 - ☐ No proposed new formal drawings have been received.
- ☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

BERNARD LIPMAN
EXAMINER
ART UNIT 155



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

BRINATI et al.

Serial Number: 08/885,770

Group Art Unit: 1713

Filed: June 30, 1997

Examiner: N. Sarofim

For: VDF POLYMERIZATION PROCESS

PETITION FOR EXTENSION OF TIME

Assistant Commissioner for Patents
Washington, D.C. 20231

January 13, 1999

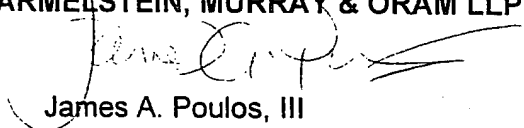
Sir:

Applicants petition the Commissioner of Patents and Trademarks to extend the time for response to the Office Action dated August 20, 1998, for a two (2) month extension from November 20, 1998 to January 20, 1999.

Enclosed please find a check in the amount of Three Hundred Eighty Dollars (\$380.00) to cover the Government Fee for this extension. In the event that this check becomes detached or is insufficient, or if any additional fees are required with respect to this paper, please charge our Deposit Account No. 14-1060.

Respectfully submitted,

NIKAIDO, MARMELSTEIN, MURRAY & ORAM LLP


James A. Poulos, III
Attorney for Applicants
Registration No. 31,714

Atty. Docket No. P8910-8056
Metropolitan Square
655 Fifteenth Street, N.W.
Suite 330 - G-Street Lobby
Washington, D.C. 20005-5701
(202) 638-5000
POU:fcs
Enclosures: Response / Check #18459



NIKAIDO, MARMELESTEIN, MURRAY & ORAM LLP

Docket No. P8910-8056

Date January 13, 1999

**REQUEST FORM FOR CONTINUING PROSECUTION APPLICATION
UNDER 37 C.F.R. §1.53(d)**

Assistant Commissioner for Patents
Box CPA
Washington, D.C. 20231

This is a Request for filing a xx continuation or -- divisional application under 37 C.F.R. §1.53(d) of prior Application No. 08/885,770, filed on June 30, 1997 entitled:

VDF POLYMERIZATION PROCESS

By the following named inventor(s):

Giulio BRINATI; Paolo LAZZARI; and Vincenzo ARCELLA

The above identified prior application in which no payment of the issue fee, abandonment of, or termination of proceedings has occurred, is hereby expressly abandoned as of the filing date of this new application. The Prior Application identified above was a non-provisional application that is complete as defined by 37 C.F.R. §1.51(b) or a national stage of an international application in compliance with 35 U.S.C. §371 and was filed on or after June 8, 1995.

1. xx Enter the non-entered amendment previously filed on November 18, 1998 under 37 C.F.R. §1.116 in the prior non-provisional application.
2. xx- A Preliminary Amendment is enclosed.

The filing fee is calculated on the basis of the claims existing in the prior application as amended at 1 and 2 above.

	Number Filed	Number Extra	Rate	Basic Fee
				\$760.00
Total Claim(s)	13 - 20	0	x 18.00	\$760.00
Independent Claim(s)	1 - 3	0	x 78.00	\$--
-- Multiple Dependent Claims			+ 260.00	\$--
TOTAL				\$760.00
Reduction by 1/2 for small entity				\$--
TOTAL FILING FEE =				\$760.00

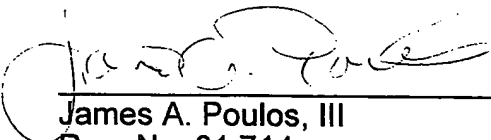
3. XX Our check in the amount of Seven Hundred Sixty Dollars (\$760.00) is enclosed to cover the required fees. In the event that any other fees are required with respect to the filing of this application, please charge our Deposit Account No. 14-1060. Any overpayment may be credited to the same account.

4. = A new oath or declaration is included.
5. = A Verified Statement to establish small entity status under 37 C.F.R. §1.9 and §1.27 = is enclosed = was filed in the prior application and such status is still proper and desired.
6. = An Information Disclosure Statement with PTO-1449 and = references is enclosed.
7. XX Applicants hereby petition that the period for response to the Official Action dated August 20, 1998 in the parent Application No. 08/885,770, be extended, if necessary, to the filing date of the present file wrapper continuing application. The fee for any such extension may be charged to our Deposit Account No. 14-1060. -
8. XX- Also enclosed: Petition for Extension of Time

Address all future communications to:

NIKAIDO, MARMELSTEIN, MURRAY & ORAM LLP
Metropolitan Square
655 Fifteenth Street, N.W.
Suite 330 - G Street Lobby
Washington, D.C. 20005-5701
Telephone: (202) 638-5000
Facsimile: (202) 638-4808

-- January 13, 1999
(Date)


James A. Poulos, III
Reg. No. 31,714
xx Attorney or agent of record
— Filed under Section 1.34(a)

POU:fcs

Enclosures:
Petition for Extension of Time
Check No. 18459
Amendment



Art Unit: 1713

Examiner: M. SAROFIM

For: VDF POLYMERIZATION PROCESS

January 13, 1999

Sir:

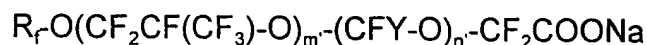
In the Claims

1.(Amended) VDF polymerization process, optionally modified with small amounts, generally comprised between 0.1 and 10% by moles, of one or more fluoro-containing comonomers, for preparing VDF polymers showing improved levels of white index, carried out in the presence of a microemulsion comprising a (per)fluoropolyether having neutral end groups, or microemulsions of fluoropolyoxyalkylenes having

hydrogen containing end groups and/or hydrogen-containing repeating units, or microemulsions of fluoropolyoxyalkylenes having hydrogen-containing end groups and/or hydrogen-containing repeating units and hydrocarbons C₁-C₂₀, of aliphatic, aromatic or mixed type, optionally containing halogens, said fluoropolyethers having number average molecular weight from 400 to 3000, and a surfactant based on perfluoropolyethers with a sodium carboxylate end group [carboxylic end group salts], said surfactant having a number molecular weight Mn comprised between 400-600, [preferably 400-550,] and having a distribution of molecular weight such that fractions having a number average molecular weight [higher] greater than 700 are not present or are present in amount of less than 5% by weight.

Kindly cancel claim 2 and rewrite it as new claim 13

--13. VDF polymerization process according to claim 1, wherein the surfactant based on perfluoropolyethers has the following formula



wherein R_f is a C1 to C3 perfluoroalkyl group, ClCF₂CF(CF₃)-, CF₃CFCICF₂-, ClCF₂CF₂-, ClCF₂-, Y=-F, CF₃; m' and n' are integers meeting the requirements of the number average molecular weight recited in claim 1. --

Kindly add the following new claim 14:

--14. The VDF polymerization process according to claim 1 wherein said surfactant has a number average molecular weight Mn comprised between 400-550.--

REMARKS

In order to more particularly point out the claimed invention, claim 1 is amended and claim 2 is rewritten as claim 13. The amendments in claim 1 find support in the specification at page 5, lines 21-23 and new claim 13 is supported by the specification at page 10, lines 6-10. No new matter is added.

It is applicant's position that amended claim 1 clearly recites novel limitations for producing a VDF polymer solving the technical problems existing in the art. The present invention is distinguished over Giannetti et al (US 4,864,006) and Abusleme et al (EPO 625,526).

The process of the invention is carried out in order to obtain VDF polymers endowed with improved levels of white index even after thermal treatment at high temperatures. Nowhere in the prior art cited by the Examiner is there any hint that the

process claimed in these patents would impart to the VDF polymers the properties above cited.

The results of the present invention are obtained by employing a surfactant based on perfluoropolyethers (PFPE) having carboxylic end group salified with a sodium salt. This feature is not present in the prior art cited by the Office. In fact, Giannetti's invention is carried out by using a surfactant PFPE having a carboxylic end group salified with NH_4^+ while Abusleme's invention is carried out by using a surfactant PFPE having a carboxylic end group salified with K^+ . Furthermore, both Abusleme's and Giannetti's examples relate to a polymerization processes for producing tetrafluoroethylene (TFE) and not to processes for preparing VDF.

The Applicant has surprisingly and unexpectedly found that the use of a surfactant based on perfluoropolyethers with carboxylic end groups salified with NaOH and having the *narrow distribution of molecular weight (MWD) as recited in claim 1*, enables the manufacturer to obtain VDF polymers endowed with improved levels of white index in comparison with salified surfactants not having the MWD as recited in claim 1 of the present application.

Thus, applicants respectfully traverse the position of the Office that "Giannetti's 6 carbon surfactants as disclosed would inculcate to applicants claimed molecular weight". Even if Giannetti's surfactants have an average molecular weight within the range of claim 1, these surfactants surely do not possess the molecular weight distribution such that fractions having a number average weight greater than 700 are present in amount less than 5% by weight. In fact, in Giannetti's invention no such selection of fractions having a number average weight is disclosed in order to reduce the presence in the surfactant of the fractions having molecular weights greater than 700. This is an important point because it is this characteristic of the process that allows one to obtain Applicant's improvement. The key feature of Applicant's invention is to reduce in the surfactant the presence of said fractions to an amount less than 5% by weight.

The Office should take note that comparative Example 3 of the present application is an example disclosing the use of a microemulsion according to Giannetti et al, wherein the surfactant has an average molecular weight of 570, but it contains 28% by weight of fractions having a molecular weight greater than 700. This surfactant, characterized by a wide distribution of molecular weights, is outside the conditions recited in claim 1 of the present application. In fact, the surfactant according to Giannetti causes the final polymer product to have large values of residual surfactant

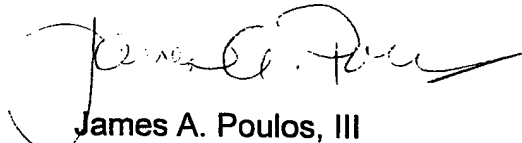
and low levels of white index. This is shown in tables 2 and 3 of the specification, wherein comparisons between the microemulsion according to the present invention (Example 1) and microemulsion according to Giannetti et al (Example 3) are presented.

Furthermore, in these documents there is neither mention of a surfactant possessing the characteristics of claim 1 of the present invention nor disclosure directed to discoloration and the white index of the final polymer. Consequently, a person of ordinary skill in the art would not infer from these references how to solve the technical problem solved by the present invention.

In view of the foregoing applicants respectfully submit that the subject application is now in condition for a receipt of a Notice of Allowance.

In the event this paper is deemed not timely filed the applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No.14-1060 along with any other additional fees which may be required with respect to this paper; any overpayment should be credited to the account.

Respectfully submitted,
Nikaido, Marmelstein, Murray & Oram, LLP



James A. Poulos, III
Registration No. 31,714

Nikaido, Marmelstein, Murray & Oram, LLP
Metropolitan Square
655 Fifteenth Street, NW
Washington, D.C. 20005-5701
(202) 638-5000

Attorney Docket No. 8910-8056